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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 963,347	09 25 2001	J. Fernando Bazan	DX0903K1	9754

28008 7590 05 19 2003

DNAX RESEARCH, INC.  
LEGAL DEPARTMENT  
901 CALIFORNIA AVENUE  
PALO ALTO, CA 94304

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT PAPER NUMBER

1646

DATE MAILED: 05 19 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/963,347

Applicant(s)

BAZAN ET AL.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application.
4. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 120.
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1. ☐ Notice of Transfer of Rights (PTO 854)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO 844)
3. ☐ Information Disclosure Statement(s) (PTO 1449, Paper No. \_\_\_\_)
4. ☐ Notice of Amendment to the Specification (PTO 853)
5. ☐ Notice of Amendment to the Claims (PTO 853)
6. ☐ Other

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 9-10, drawn to polynucleotides, vectors, host cells and methods of making a polypeptide, classified in class 435, subclass 69.1, for example.
  - II. Claim 8, drawn to a method of forming a duplex, classified in class 435, subclass 504, for example.
  - III. Claims 11-12, 15, drawn to binding compounds, classified in class 530, subclass 387.1, for example.
  - IV. Claims 13-14, drawn to methods of using the binding compound, classified in class 436, subclass 501, for example.
  - V. Claims 16-18, drawn to a polypeptide, classified in class 530, subclass 350, for example.
  - VI. Claims 19-20, drawn to a method of modulating physiology of a cell, involving agonist of a primate IL-B50, classified in class 435, subclass 375, for example.
  - VII. Claims 19-20, drawn to a method of modulating physiology of a cell, involving antagonist of a primate IL-B50, classified in class 435, subclass 375, for example.

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using

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the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group I could be used in an entirely different method, such as for production of polypeptides, rather than in a method for forming a duplex of Group II.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Further, antibodies of Group III can also be used in materially different methods, such as in various diagnostic (e.g. as a probe in immunoassays or immunochromatography), or therapeutic methods.

4. Inventions I and (IV, VI-VII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides of Group I are not required for the methods of Groups IV and VI-VII.

5. Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group I and polypeptides of Group V are distinct inventions because they are physically and functionally distinct chemical entities, and the

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protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization assay.

6. Inventions II, IV and VI-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to different methods that recite structurally and functionally distinct elements, are not required one for the other, achieve different goals, and therefore are patentably distinct.

7. Inventions (II, VI-VII) and (III, V) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the binding compounds of Group III or polypeptides of group V are not required for the method of forming a duplex of Group II or methods of modulating a cell physiology of Groups VI-VII.

8. Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product claimed can be used in a materially different process of using that product (MPEP

different manner, such as in a method of protein purification, rather than in methods of group 1).

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9. Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group V and antibodies of Group III are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and entirely different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein.

10. Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods that recite structurally and functionally distinct elements, such as agonist/antagonist, are not required one for the other, achieve opposite goals, and are therefore patentably distinct.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and extensive literature searches, restriction for examination purposes as indicated

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-0294 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

For the fax should be directed to (703) 308-4556 or (703) 308-4242. If

PLEASE NOTE:

number. Faxed draft or informal communications with the examiner should be

308-0294. Duplicate papers should NOT be faxed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.  
May 9, 2003.

